

## **REMARKS**

Claims 1-15 are pending in the application.

The Examiner has objected to Tables 1 and 2 of the specification. Applicants traverse this objection. In response, Applicants respectfully direct the Examiner's attention to MPEP 608.01 quoting 37 CFR § 1.58 that "the description portion of the specification may contain tables...presented in compliance with § 1.52(a) and (b)." Applicant's respectfully request clarification from the Examiner regarding precisely how Tables 1 and 2 are non-compliant with 37 CFR § 1.52(a) and (b). Specifically, Applicants find neither statutory support nor support in the MPEP for the Examiner's objection to the tables as "lengthy" and the Examiner's concern with a lack of "numbered elements." Moreover, Applicants request clarification of the Examiner's statement that "(t)hese are not described in the specification." Applicants respectfully note that Tables 1 and 2 are part of the specification as set forth under 37 CFR § 1.58.

### **Independent Claims 1, 6 and 11**

The Examiner has rejected claims 1-15 under 35 USC 103(a) as being unpatentable over Mann in view of Belfiore. Applicants respectfully traverse this rejection. Applicants assert that neither Mann nor Belfiore, alone or in combination, provide the subject matter of the rejected claims.

Applicants respectfully disagree with the Examiner's assertion that "Mann teaches the claimed, "storing a plurality of content categories"" (Office Action of July 19, 2004; page 4, Ins. 4-5). In particular, the Examiner asserts that Mann teaches *storing a plurality of content categories* in the form of Mann's disclosed data store 110 "for storing adjunct terms and, possibly, available domain name lists" (Office Action of July 19, 2004; page 4, Ins. 5-7 quoting Mann; col. 3, Ins. 50-52). Applicants assert that adjunct terms and/or available domain name lists do not correspond to the claimed plurality of content categories. There is no teaching in

Mann that the disclosed data store for adjunct terms and/or available domain name lists is categorized in terms of content. Moreover, if, as Applicants assert, Mann fails to teach storing a plurality of content categories, then Mann also fails to teach identifying at least one search engine, suited to service a query, *having at least one content category of the plurality of content categories*. Applicants respectfully request clarification from the Examiner regarding how Mann's adjunct terms and/or available domain name lists correspond to the claimed plurality of content categories.

Further, Applicants respectfully disagree with the Examiner's assertion that, other than teaching a plurality of search engines, Mann teaches *identifying, according to properties returned by a plurality of search engines, at least one search engine suited to service a query*. Applicants note that the claimed act of *identifying* is according to properties returned and results in the identification of *at least one search engine suited to search a query*. Applicants respectfully assert that the Examiner fails to consider the claimed invention as a whole when, in her rejection, the Examiner states that Mann teaches the claimed *identifying* through Mann's disclosure of a system in which "users may access a domain name service and system and receive lists of available candidate names." (Office Action of July 19, 2004; page 4, Ins. 7-9). without showing the Applicants where or how Mann teaches *identifying, according to properties returned by*. Applicants maintain that Mann's disclosure of a domain name registration system does not teach this aspect of the claimed invention.

Even assuming, for the sake of argument, that Mann teaches the claimed *storing a plurality of content categories* and the claimed *identifying, according to properties returned by*, which Applicants maintain Mann does not, Belfiore still fails to correct the deficiencies of Mann.

Applicants respectfully remind the Examiner that in determining the differences between the alleged prior art and the claimed invention the question for the Examiner is not whether "the differences themselves would have been obvious, but whether the invention as a whole would

have been obvious.” (emphasis in original). MPEP 2141.02 (citing Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fed. Cir. 1983)). In making her rejection, the Examiner has relied upon Belfiore’s teaching of a plurality of engines to supplement the inadequate teachings of Mann. (Office Action of July 19, 2004; page 4, Ins. 19-21). However, as discussed above, Applicants assert that the Examiner has failed to properly read the limitations of claim 1 as reflects the claimed invention as a whole. Claim 1 clearly recites identifying at least one search engine *according to properties returned by a plurality of search engines* (emphasis added). (Claim 1, line 3). Thus, by considering Mann’s disclosure to be deficient for only failing to disclose “a plurality of search engines” the Examiner has failed to consider obviousness in the context of the claimed invention as a whole.

Moreover, assuming, for the sake of argument, that Mann teaches the claimed invention excepting for the plurality of search engines, which Applicants believe Mann does not, Applicants respectfully maintain that Mann reference does not relate nor is it analogous to the subject matter of the claimed invention. Applicants respectfully direct the Examiner’s attention to MPEP 2141.01(a) wherein states that “to rely on a reference under 35 U.S.C. 103, it must be analogous prior art” where “the reference must either be in the field of the applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned.” (citing *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992)).

Mann’s field of endeavor “relates to systems and methods used to facilitate registration and transfer of domain names and uniform resource locators.” (Mann, col. 1, lines 8-10). In contrast, the claimed invention relates to the field of searching for information. (Specification, page 2, line 5). Thus, Applicants assert that Mann is not in the same field of endeavor as the claimed.

Moreover, Applicants maintain that Mann is not reasonably pertinent to the claimed invention. Mann clearly teaches that candidate domain names are cleared against only one

external database housed at one external website (i.e., InterNIC). (Mann, col. 5, lines 34-37). Mann clears candidate domain names against a known external database precisely because it is this database that is recognized as the authoritative repository of registered domain names. Thus, Applicants assert that Mann does not teach, nor does Mann require, a method or system for identifying a particular search engine based on the properties of a plurality of search engines – Mann teaches a system that already knows where to obtain the desired information. Hence, Mann is not analogous to the claimed invention. The Examiner cites one search engine in Mann (i.e., Fig. 5A “search button”) suited to service a query (i.e., Fig. 5A, item #507) but does not explain how that search engine is identified according to properties returned by a plurality of search engines in accordance with the claimed invention. Appellants respectfully assert that the Examiner has not done so precisely because Mann already knows where to find information regarding registered domain names.

Nonetheless, even assuming, for the sake of argument, that Mann relates to or is analogous to the subject matter of the claimed invention, which Applicants assert Mann does not, Applicants respectfully assert that the combination of Mann with Belfiore fails to establish a *prima facie* case of obviousness. Applicants respectfully direct the Examiner’s attention to MPEP 2143.01 wherein states that a *prima facie* case of obviousness can

only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art (emphasis added)

(citing In re Kotzab, 217 F.3d 1365 (Fed. Cir. 2000)).

Applicants assert that one of ordinary skill in the art having read and understood the disclosure of Mann would not look toward the teachings of Belfiore. In particular, Mann’s teachings are directed towards the solution of expediting the identification of registrable domain

names. (Mann, col. 2, lines 19-21). In doing so, Mann clearly teaches that candidate domain names are cleared against only one external database housed at one external website (i.e., InterNIC). Only the InterNIC database serves as an authoritative source of information on registered domain names. Thus, Mann provides no motivation for one of ordinary skill in the art to modify a disclosure that relies upon a known website-accessible database to include a plurality of search engines returning properties to enable identification of a particular search engine – Mann's disclosure has no need for multiple search engines.

Belfiore likewise fails to provide the requisite motivation or suggestion to combine. Applicants assert that one of ordinary skill in the art having read and understood the disclosure of Belfiore would not look toward the teachings of Mann. In particular, Belfiore's teachings relate to "intelligent automatic searching for computer resources in a distributed environment." (Belfiore, col. 1, lines 7-8). In particular, Belfiore's teachings are directed towards "a method for automatically initiating a search for a resource such as a web site when a user has specified (entered) text that is not a valid identifier for the resource, e.g., a uniform resource locator (URL)." (Belfiore, col. 2, lines 13-16). In other words, Belfiore relates to the problem of automatically correcting the misspelling of a URL where Belfiore attempts to obtain the correct URL in part by assessing "the specific suitability of a plurality of search engines to locate web sites related to the determined meaning of the specified text." (Belfiore, col. 2, lines 46-48). Thus, Belfiore provides no motivation for one of ordinary skill in the art to modify a disclosure that relies upon a plurality of search engines to locate web sites to include searching domain names against a known website-accessible database of registered domain names because Belfiore's disclosure has no need for clearing candidate domain names against known registered domain names.

Thus, Applicants respectfully assert that the Examiner has failed to adhere to the admonition that a *prima facie* case of obviousness can only be established by providing "some

objective reason to combine the teachings of the references.” MPEP 2143.01 (citing Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Nonetheless, even assuming, for the sake of argument, that Mann or, for that matter, Belfiore provides proper motivation to combine, which Applicants assert neither reference does, the combination would still fail because to incorporate the teachings of Belfiore into Mann would change the principle of operation of Mann.

If the Examiner's asserted combination or modification would “change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” MPEP 2143.01 (citing In re Gordon, 733 F.2d 900 (Fed. Cir. 1984). The Examiner argues that it would be obvious to modify the teachings of Mann with the teachings of Belfiore with the “motivation to automatically retrieve information regarding appropriate web sites so that the user can gain access to the desired web site.” (Office Action of July 19, 2004; page 5, Ins. 1-8). But to do so would change the principle of operation of Mann's invention. As discussed above, Mann discloses a method and system for identifying registrable domain names against a well-known database located at a single website (i.e., InterNIC). Applicants assert that, assuming for the sake of argument that the asserted combination produces the subject matter of the rejected claims, which Applicants assert it does not, modifying Mann with Belfiore by incorporating a plurality of search engines with, as the Examiner has asserted, the intention of automatically retrieving information regarding appropriate web sites would supply no useful function to Mann's teachings and, moreover, would only divert resources (e.g., network communications bandwidth) from Mann's disclosed purpose of clearing candidate domain names against the InterNIC database.

In conclusion, Applicants maintain that the Examiner has failed to make a *prima facie* case of obviousness under 35 U.S.C. § 103, and it is therefore respectfully requested that the Examiner withdraw her rejection of claims 1-15.

Application No. 09/752,799  
Reply to Office Action of July 19, 2004  
Attorney Docket: 42390.P10833

### CONCLUSION

In view of the foregoing, it is respectfully asserted that all of the claims pending in this patent application are in condition for allowance.

Should it be determined that an additional fee is due under 37 CFR §§1.16 or 1.17, or any excess fee has been received, please charge that fee or credit the amount of overcharge to deposit account #02-2666.

If the Examiner has any questions, she is invited to contact the undersigned at (503) 264-6473. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Respectfully submitted,



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Dated: August 10, 2004

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